

200312102-1

10/789,963

REMARKS

This is a full and timely response to the non-final Official Action mailed **August 3, 2007**. Reconsideration of the application in light of the following remarks is respectfully requested.

Claim Status:

Claims 26-45 and 59-70 were withdrawn from consideration under a previous Restriction Requirement and cancelled without prejudice or disclaimer. Claims 1-25, 46, 47 and 50 were also cancelled previously without prejudice or disclaimer.

By the present paper claim 54 and claims 73-79 are cancelled without prejudice or disclaimer to expedite the prosecution of this application. Additionally, new claims 80-90 have been added. Thus, claims 48, 49, 51-53, 55-58, 71, 72 and 80-90 are currently pending for further action.

Prior Art:

Claims 48, 49, 51-53, 55-58 and 71 were rejected as anticipated under 35 U.S.C. § 102(e) or, in the alternative, as unpatentable under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,375,320 to Chen et al. (Action of 8/3/07, p. 3). This rejection is confusing because U.S. Patent No. 6,375,320 is to Chu et al., not Chen et al. There is a Chen et al. reference of record that has been applied in a past Office Action. However, the citations in the Office Action appear to refer to U.S. Patent No. 6,375,320. Consequently, in an attempt to advance the prosecution of this application, Applicant presumes that this rejection is based on U.S. Patent No. 6,375,320 to Chu et al. ("Chu") and responds accordingly. If this presumption is incorrect, Applicant requests a non-final clarification of the grounds of the rejection.

200312102-1

10/789,963

Claim 48 now recites:

A print medium having a microporous coating comprising:
a substrate which serves as a base of said print medium;
a first microporous layer comprising a first binder deposited as a liquid on said substrate; and
a fusible latex layer deposited over said first microporous layer, wherein said fusible latex layer is microporous and includes particles comprising a hard core material and a soft shell material;
wherein said latex exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer without requiring a second binder and without being fused.

Support for the amendment to claim 1 can be found in Applicant's originally filed specification at, for example, paragraph 0021.

In contrast, Chu does not teach or suggest the claimed print medium comprising a base substrate, a first microporous layer and a fusible latex layer deposited over the first microporous layer. There is no such teaching in Chu.

Additionally, Chu teaches the use of binder in a latex layer. (Chu, col. 4, lines 30-32).

This is expressly contrary to claim 48 which recites that the "latex exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer *without requiring a second binder.*" (Emphasis added).

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. As demonstrated above, Chu does not teach or suggest the claimed print medium comprising a base substrate, a first microporous layer and a fusible latex layer deposited over the first microporous layer. Additionally, Chu does not teach or suggest the claimed latex layer that "exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer *without requiring a*

200312102-1

10/789,963

second binder." (Emphasis added). For at least these reasons, the § 102 rejection based on Chu of claim 1 and its dependent claims should be reconsidered and withdrawn.

With respect to the alternative § 103 rejection based on Chu, under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966), to support a rejection under § 103, the scope and content of the prior art must first be determined; followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Chu, did not include (1) the claimed print medium comprising a base substrate, a first microporous layer and a fusible latex layer deposited over the first microporous layer; or (2) the claimed latex layer that "exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer *without requiring a second binder.*" (Emphasis added). This subject matter appears to be outside the scope and content of the cited prior art to Chu.

This difference between Chu and the claimed subject matter is significant because Chu does not provide the advantages outlined in Applicant's specification. (See, Applicant's specification, paragraph 0014). Therefore, Chu will not support a rejection of claim 1 and its dependent claims under § 103(a) and *Graham*. Consequently, the rejection based on Chu should be reconsidered and withdrawn.

Claims 48, 49, 51-53, 55-58 and 71 were also rejected as anticipated under 35 U.S.C. § 102(e) in view of U.S. Patent No. 7,086,732 to Kasperchik et al. ("Kasperchik"). For at least the following reasons, Applicant respectfully traverses these rejections.

In contrast to independent claim 48, Kasperchik teaches: "The colorant-receiving layer 8 may also include a small amount of polymer binder to bind the core-shell polymer particles

200312102-1

10/789,963

10 into a layer.” (Kasperchik, col. 6, lines 49-51). Thus, like Chu, Kasperchik does not appear to anticipate the claimed subject matter in which “said latex exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer *without requiring a second binder and without being fused.*” (Emphasis added).

In this regard, the Office Action argues that Kasperchik lists a binder as an optional component and does not claim an example that includes a binder. (Action of 8/3/07, p. 4). This analysis is in appropriate. First, Kasperchik’s claim are open-ended and do not recite every component of an embodiment. Thus, there is nothing significant to the fact that Kasperchik does not expressly recite a binder in a claim.

The relevant question is what Kasperchik teaches one of skill in the art and whether that teaching includes a “latex [that] exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer without requiring a second binder and without being fused.” *Kasperchik does not teach, suggest or even mention that a latex layer can or should be applied without requiring a binder. To the contrary, Kasperchik expressly teaches that a binder may be used.*

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Moreover, MPEP 2131 further states: “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). For at least these reasons, there is no anticipation of claim 48 under § 102, and the rejection based on Kasperchik should be reconsidered and withdrawn.

200312102-1

10/789,963

RECEIVED
CENTRAL FAX CENTER

NOV 01 2007

Double Patenting:

Claims 48, 49, 51-53, 55, 57, 58, 71 and 72 were rejected on the ground of non-statutory obviousness-type double patenting in view of Kasperchik. In response, Applicant has filed herewith a terminal disclaimer with respect to Kasperchik. Following entry of this terminal disclaimer, this double patenting rejection can be reconsidered and withdrawn.

Conclusion:

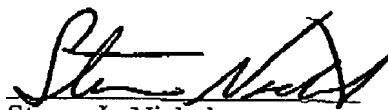
The newly added claims are thought to be patentable over the prior art of record for at least the same reasons given above with respect to the original independent claims.

Therefore, examination and allowance of the newly added claims is respectfully requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: November 1, 2007

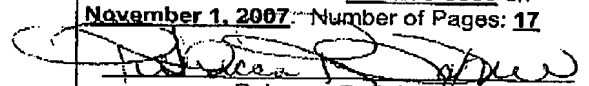


Steven L. Nichols
Registration No. 40,326

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095
(801) 572-8066
(801) 572-7666 (fax)

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office facsimile number **571-273-8300** on **November 1, 2007**. Number of Pages: **17**


Rebecca R. Schow